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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,016	01/16/2002	Albert K. Chin	80121-06566	3131

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EXAMINER

O CONNOR, CARY E

ART UNIT	PAPER NUMBER
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3732

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DATE MAILED: 01/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/052,016

Applicant(s)

CHIN ET AL

Examiner

Cary E. O'Connor

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Peri d for Reply - The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-14 and 20-25 is/are rejected.
- 7) ☒ Claim(s) 15-19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 17 November 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 23 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 23 recites the limitation "the target vessel" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 23 recites the limitation "the branch vessel" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 25 recites the limitation "the branch vessel" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilk (5,368,015). Wilk shows a surgical apparatus comprising an elongated cannula 190 including a plurality of lumens 192, 194 extending between proximal and distal ends, a retractor 266 disposed within a lumen to extend beyond the distal end of the cannula, and a surgical tool (scissors) 260 supported in a lumen and extending beyond the distal end of the cannula. As to claim 14, note that the retractor and the tool are relatively movable near the distal end of the cannula (column 9, lines 42+).

Claims 12, 13 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by De Faria-Correa et al (5,533,496). De Faria-Correa shows a surgical apparatus comprising an elongated cannula 27 including a plurality of lumens 22, 24, 26, 25 extending between proximal and distal ends, a retractor disposed within a lumen 22 to extend beyond the distal end of the cannula, and a surgical tool supported in a lumen 22 and extending beyond the distal end of the cannula. As to claim 13, note that the surgical tool may be a cutting instrument (column 4, line 59). As to claim 20, note that the cannula includes a lumen 24 for slidably supporting an endoscope 30.

Claims 21 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Bonutti et al (5,514,153). Bonutti discloses a surgical procedure performed with an elongated cannula 190 including a retractor 200 and a surgical tool 219 disposed near the distal end of the cannula. The distal end of the cannula is disposed near a tissue structure, the retractor engages the tissue structure for selective manipulation and the tissue structure is engaged by the tool to alter the tissue structure (see column 18, lines 13-25 and Figure 28). As to claim 24, note the endoscope 217.

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Claims 21-25 are rejected under 35 U.S.C. 102(e) as being anticipated by DeFonzo et al. DeFonzo discloses a surgical procedure performed with an elongated cannula 202 including a retractor 208 and a surgical tool 140 disposed near the distal end of the cannula. The distal end of the cannula is disposed near a tissue structure, the retractor and too are selectively deployed from the distal end of the cannula, the retractor engages the tissue structure for selective manipulation and the tissue structure is engaged by the tool to alter the tissue structure. As to claims 22 and 23, the retractor engages tissue structure including a target vessel V having a branch vessel B, wherein the retractor resiliently urges the target vessel away from the surgical tool and the too severs the branch vessel (see Figure 21-25). As to claim 24, note the endoscope 150.

Allowable Subject Matter

Claims 15-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Drawings

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on November 17, 2003 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

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Response to Arguments

Applicant's arguments with respect to claims 12 and 21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cary E. O'Connor whose telephone number is 703-308-2701. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-0858. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.


Cary E. O'Connor
Primary Examiner
Art Unit 3732

ceo
January 12, 2004